

**Application No. 10/026,681****Atty Docket: JGR 1009-1****REMARKS**

This response is in reply to the Final Office Action mailed 29 June 2005. Claims 1-24 are pending in this application and are presently rejected to by the Examiner.

Applicants note with appreciation that the Examiner accepted the amended drawings, specification and CD-ROM computer program listing. In addition, the Examiner withdrew objections under § 112, first paragraph.

The status of rejections under § 101 is unclear, as discussed below. We believe that the § 101 rejections also were withdrawn, based on the final paragraph of p. 13, which says so and is not followed by any response to Applicants' remarks.

Claims 1, 3-8, 10-16 and 18-24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Probst et al. (U.S. Patent Application Publication No. 2003/0140034, hereafter "Probst"), in view of Elliott Rusty Harold ("XML: Extensible Markup Language," IDG Books Worldwide, Inc., Foster City, CA, © 1998, hereafter "Harold").

Claims 2, 9 and 17 are also rejected under 35 U.S.C. 103(a) as being unpatentable over Probst, in view of Harold, and in further view of XML Path Language (XPath) Version 1.0 (W3C Recommendation, 16 November 1999, hereafter "XPath Spec).

**The Examiner's responses and our replies are emphasized in BOLD face, for easy reference.**

**Rejection Under 35 U.S.C. § 101 of Claims 1-14 and 16-22**

The Examiner says in bottom paragraph on p. 13 of the FOA that the § 101 rejections are among the rejections withdrawn. We believe that page 2, § 4 is mistaken when it says that these rejections were maintained.

**Rejections Under 35 U.S.C. § 103(a)**

The Examiner rejects **claims 1, 3-8, 10-16 and 18-24** under 35 U.S.C. § 103(a) as unpatentable over Probst et al. (U.S. Pat. App. Pub. No. 2003/0140034, claiming benefit of a provisional filing not provided by the Examiner) in view of Elliott Rusty Harold (XML: Extensible Markup Language, IDG Books Worldwide, Inc., Foster City, CA, (c) 1998), with a newly added reference to The American Heritage College Dictionary, 4<sup>th</sup> Edition, Houghton Mifflin Co., Boston, (2002) p. 705.

**Application No. 10/026,681**

**Atty Docket: JGR 1009-1**

**Claim 1**

**Claim 1** includes the limitations:

*providing a graphical user interface including*

*a document type selection filter;*

*one or more document field selection filters, context sensitive to a selected document type;*

*one or more value specification fields, context sensitive to the document fields;*

We previously pointed out that these limitations are not found in Probst et al. references 503 and 705 or in [0056]. The user interface support for entry of keywords 502 (document fields) is not context sensitive to a selected asset category 503 (document type), as asset category is entered after keywords, and keywords are values found in document fields, as opposed to selections of document fields to search. Reference 705 does not represent part of a graphical user interface, as FIG. 7 depicts a DTD schema, not a graphical user interface.

The Examiner countered that “the asset category of FIG. 5 provides a context for keyword searching.” This argument is disconnected from the words of the claim. The claim calls for the *user interface* to provide document field selection filters, context sensitive to a selected document type and value specification fields context sensitive to the document fields. The context for keyword searching, to which the Examiner refers, resides in the backend or database and query processing and therefore does not meet the words of the claim, which refer to the front end user interface.

**Claim 1** further includes the limitations:

*as non-displaying fields, one or more path specifications corresponding to the document fields and to the value specification fields, said path specifications identifying nodes to be tested against completed value specifications*

These limitations are not found in Harold, p. 268 as embedding path specifications in non-displaying fields of a graphical user interface. Harold describes an XPointers programming construct for bringing data (not path specifications) from a known location within an XML document into an HTML page, not a graphical user

**Application No. 10/026,681****Atty Docket: JGR 1009-1**

interface. Harold explains at p. 271, "XPointers refer to particular parts of or locations in XML documents."

**The Examiner further argues that HTML is a graphical user interface, which is agreed, but not responsive to the words of the claim. Harold's XPointers do not provide the claimed features; they are used to import text directly into an HTML page; there is no teaching of embedding within the HTML page non-displaying fields including path specifications, as claimed.**

Therefore, claim 1 should be allowable over Probst et al. in view of Harold.

**Claims 3-7**

**Claims 3-7** are allowable over Probst et al. in view of Harold for at least the same reasons as claim 1, from which they depend.

**Claim 8**

The Examiner's rejection of **Claim 8** mirrors the rejection of claim 1, without hidden field limitations and with the following added limitations:

*looking up path specifications corresponding to the document field identifiers, said paths specifications identifying nodes to be tested against completed value specifications;*

*searching a subset of the self-describing, structured documents based on the completed value specifications and the corresponding path specifications, the subset including documents of the selected document type.*

The providing and receiving limitations are not found in Probst et al. in view of Harold, for the reasons presented while traversing rejection of claim 1.

Probst et al. [0034] does not meet the searching limitations because the description of Advanced Search Screen 107 does not include the same detailed limitations as the claim.

Harold pp. 260, 264 and 268 do not meet the looking up path specifications corresponding to the document field identifiers limitation because Harold describes an XPointers programming construct for bringing data from a known location within an XML document into an HTML page, which is not what is claimed. Again, Harold explains at p. 271, "XPointers refer to particular parts of or locations in XML documents", which is not a search construct and not a way to specify a path to a set of documents.

**Application No. 10/026,681****Atty Docket: JGR 1009-1**

At this point, the Examiner is extrapolating beyond anything found in Probst or Harold, using the present claims as a roadmap for applying prior art tools. Applicants see no teaching in either Probst or Harold to produce the claimed invention as a whole. *Ruiz v. A.B. Chance*, 357 F.3d 1270, 1275, 69 U.S.P.Q.2d (BNA) 1686 (Fed. Cir. 2004) (section 103 specifically requires consideration of the claimed invention "as a whole."); *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1337, 75 U.S.P.Q.2d (BNA) 1051 (Fed. Cir. 2005) (reciting *Ruiz* rule; "simply identifying all of the elements in a claim in the prior art does not render a claim obvious"); *see also*, 2-5 Chisum on Patents § 5.03 [2][c] n. 29 (2005 Lexis version); *e.g. ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546, 48 USPQ2d 1321, 1329 (Fed. Cir. 1998) ("Determination of obviousness can not be based on the hindsight combination of components selectively culled from the prior art to fit the parameters of the patented invention."); *Grain Processing Corp. v. American Maize-Products Corp.*, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988) ("Care must be taken to avoid hindsight reconstruction by using 'the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.' "). Accordingly, Applicants submit that the Examiner is relying on impermissible hindsight, and limitations not found in the combination relied upon, in rejecting the claims.

**The Examiner did not respond to this basis for distinguishing over the combination.**

Therefore, claim 8 should be allowable over Probst et al. in view of Harold.

#### Claims 10-14

**Claims 10-14** are allowable over Probst et al. in view of Harold for at least the same reasons as claim 1, from which they depend.

#### Claim 15

The Examiner's rejection of **Claim 15** again mirrors rejection of claim 1. Claim 15 includes many of the limitations of claim 1, excepting the searching element.

Therefore, claim 15 should be allowable over Probst et al. in view of Harold for the same reasons as claim 1.

**Application No. 10/026,681****Atty Docket: JGR 1009-1****Claim 16**

The Examiner's rejection of **Claim 16** once again mirrors rejection of claim 1. Claim 15 includes many of the limitations of claim 1, excepting the receiving and searching elements. Therefore, claim 16 should be allowable over Probst et al. in view of Harold for the same reasons as claim 1.

**Claims 18-22**

**Claims 18-22** are allowable over Probst et al. in view of Harold for at least the same reasons as claim 17, from which they depend.

**Claim 23**

**Claim 23** be allowable over Probst et al. in view of Harold for the same reasons as claim 1.

**Claim 24**

**Claim 24** includes the limitations:

*loading a set of document field and path specification pairs, said path specifications identifying nodes of self-describing, structured documents to be indexed and searched;*

*indexing portions of the documents corresponding to the document field and path specification pairs;*

Other limitations are not found in Probst et al. in view of Harold, for the reasons provided in traversal of the claim 1 rejection.

The loading element is not met by Probst et al. reference 503, which is part of a search GUI and not a preparation to index and search.

The indexing element is not met by Probst et al. [0016], which reads in its entirety:

[0016] In accordance with this invention, data definitions are provided for digital assets that include a hierarchical structure that reflects the relationships between attributes and categories of content. These definitions, preferably encoded in XML, can be used as a standardized dictionary to create a digital asset library that is easily and economically manageable. The data definitions are applicable to digital assets of disparate data types and include metadata identifiers sufficient to uniquely identify those digital assets.

**The Examiner argues that it is inherent that Indexing must have occurred to implement a searchable digital library. Because brute force is an alternative, inherency is not the right principle to invoke. Inherency only applies when it is**

Application No. 10/026,681

Atty Docket: JGR 1009-1

logically necessary to use a particular approach. To apply inherency, the non-explicitly disclosed element must be necessarily present in the reference and be recognized as necessarily present by one of ordinary skill in the art. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949 (Fed. Cir. 1999). Furthermore, inherency "may not be established by probabilities or possibilities [and] [t]he mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Id.* (emphasis added by Applicant). On the other hand, reference to the database as being an SQL database implicitly suggests indexing, where efficient.

Therefore, claim 24 should be allowable over Probst et al. in view of Harold for at least the same reasons as claim 1.

Applicants respectfully submit that claims 1, 3-8, 10-16 and 18-24 should be allowable over Probst et al. in view of Harold.

**Rejection Under 35 U.S.C. § 103(a) of Claims 2, 9 and 17**

The Examiner rejects **claims 2, 9 and 17** under 35 U.S.C. § 103(a) as unpatentable over Probst et al. (U.S. Pat. App. Pub. No. 2003/0140034, claiming benefit of a provisional filing not provided by the Examiner) in view of Elliotte Rusty Harold (XML: Extensible Markup Language, IDG Books Worldwide, Inc., Foster City, CA, (c) 1998) and further in view of XML Path Language (XPath) Version 1.0 (W3C Recommendation 19 November 1999).

Applicants respectfully submit that claims 2, 9 and 17 should be allowable over Probst et al. in view of Harold and further in view of XPath Spec for at least the same reasons as the claims from which they depend.

**Application No. 10/026,681**

**Atty Docket: JGR 1009-1**

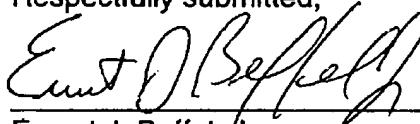
**CONCLUSION**

Applicants respectfully submit that the pending claims are now in condition for allowance and thereby solicit acceptance of the claims, in light of these amendments.

The undersigned can ordinarily be reached at his office at (650) 712-0340 from 8:30 a.m. to 5:30 p.m. PST, Monday through Friday, and can be reached at his cell phone at (415) 902-6112 most other times.

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Respectfully submitted,



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